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09/879,302	08/06/2001	Nozomu Ikeda		6158

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LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/879,302	<b>Applicant(s)</b> IKEDA	
	<b>Examiner</b> Paul Callahan	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 76-115, 124-131 and 146 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76-92, 106-115, 131 and 146 is/are allowed.
- 6) ☐ Claim(s) 93, 94, 97-105 and 124-130 is/are rejected.
- 7) ☐ Claim(s) 95 and 96 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/131,095.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-5-2006</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 76-145 were pending in the instant application at the time of the previous Office Action. By the latest amendment, filed September 21, 2006, claims 116-123 and 132-145 have been cancelled, and new claim 146 added. Therefore claims 76-115, 124-131 and 146 are pending and have been examined.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on September 21, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,282,684 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

3. Applicant's arguments, filed September 21, 2006, with respect to the rejection(s) of claim(s) 77-128 and 131-145 under 35 USC 112 and 35 USC 101 have been fully considered and, when taken together with the changes made to the language of the claims via the latest amendment filed are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Park, US 6,028,932.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 93, 94, 97, 98, 100-103, 124-126, and 129 are rejected under 35 U.S.C. 102(e) as being anticipated by Park.

As for claim 93, Park teaches an information signal reproducing device for reproducing information signals to which device-related information has been added (abstract, fig. 4 VCR A, VCR B, fig. 5: VCR set, col. 2 lines 59-67, col. 3 lines 1-23), the reproducing device comprising: device-related information obtaining means for obtaining device-related information related to the reproducing device for reproducing the information signals (col. 2 line 59 to col. 3 line 23); information signal input means for inputting the information signals (fig. 4, col. 4 lines 45-50); detecting means for detecting the device-related information added to the information signals from the information signal input means (fig. 6 element 10: Header Detector, col. 4 lines 8-15) ; determining means for determining whether the device related information from the

Art Unit: 2137

device-related information obtaining means is consistent with the device-related information detected by the detecting means (fig. 6 element 20, fig. 9 element 20, col. 3 lines 17-23); and control steep-means for prohibiting the reproduction of the information signals if the device-related information from the reproducing-side device-related information obtaining means is not consistent with the device-related information detected by the detecting means (col. 3 lines 17-23).

As for Claim 98, Park teaches the information signal reproducing device according to claim 93, further comprising information signal blocking means for blocking the reproduction of the information signals when the determined result from the determining means indicates that the device-related information from the device-related information obtaining means is not consistent with the device-related information detected by the detecting means (col. 2 lines 59-67, col. 3 lines 1-23).

As for claim 101, park teaches an information signal reproducing device for reproducing information signals to which device-related information has been added and which are recorded on a recording medium (abstract, fig. 4 VCR A, VCR B, fig. 5: VCR set, col. 2 lines 59-67, col. 3 lines 1-23), the reproducing device comprising: device-related information obtaining means for obtaining the device-related information related to the reproducing device for recording the information signals (col. 2 line 59 to col. 3 line 23); information signal reading means for reading the information signals from the recording medium (fig. 4, col. 4 lines 45-50); additional information detecting means

Art Unit: 2137

for detecting the additional information added to the information signals from the information signal reading means on the basis of the device related information obtained by the device-related information obtaining means (fig. 6 element 10: Header Detector, col. 4 lines 8-15); and control means for prohibiting the reproduction of the information signals if the additional information added to the information signals is not detected by the additional information detecting means (col. 3 lines 17-23).

As for claims, 94 and 102, Park teaches the information signal reproducing device according to claims 93 and 101, further comprising auxiliary recording medium setting means into which an auxiliary recording medium is set, wherein the device-related information obtaining means comprises means for obtaining the device-related information from the auxiliary recording medium set into the recording-side auxiliary recording medium setting means (fig. 4 "tape A" playback mode)

As for claims 97 and 103, Park teaches the information signal reproducing device according to claims 93 and 101, wherein the additional information added to the information signals is generated by using the device-related information as an enciphering key to carry out enciphering (col. 6 lines 20-55) and wherein the additional information detecting means comprises means for detecting the additional information added to the information signals from the information signals reading means by using

Art Unit: 2137

the device-related information from the device-related information obtaining means as a decoding key to carry out decoding (col. 6 lines 20-55).

As for Claim 100, Park teaches the information signal reproducing device according to claim 93, wherein the device related information added to the information signals is superimposed on the information signals using a first code, and said detecting means comprises means for providing second code for providing code identical with said first code, and means for detecting the device-related information superimposed on the information signal by processing a detecting process using said second code (col. 3 lines 1-23).

As for claim 124-126, the claims are directed to the method of using the device of claims 101-103. Claims 124-126 recite substantially the same limitations as claims 101-103 and are therefore rejected on the same basis as are those claims.

As for claim 129, the claim recites substantially the same limitations as claims 101-103 and is therefore rejected on the same basis as are those claims.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2137

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 99, 104, 105, 127, 128, and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park.

As for claim 99, Park teaches the information signal reproducing device according to claims 93, but not further comprising informing means for informing a user that the information signals are not reproduced when the determined result from the determining means indicates that the device-related information from the reproducing-side device-related information obtaining means is not consistent with the device-related information detected by the detecting means. However official notice may be taken that the use of such a step is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Park. It would be desirable to do so since this would aid in the user determination if the content is a valid copy or is an unauthorized copy.

As for claim 104, Park teaches the information signal reproducing device according to claim 101, but not further comprising information signal erasing means for erasing the information signals recorded on the recording medium when the additional information cannot be detected from the information signals by the additional



Art Unit: 2137

information detecting means. However Official Notice may be taken that such a feature is old and well known in the art. Virtually all commercial VCR's will have an erase function. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Park. It would be desirable to do so since this would permit the user to destroy an unauthorized copy of the content.

As for claims 127 and 130, the claim recites substantially the same limitations as claim 104 and are therefore rejected on the same basis as is that claim.

As for claim 105, Park teaches the information signal reproducing device according to claim 101, but not further comprising informing means for informing a user that the information signals are not reproduced when the additional information cannot be detected from the information signals by the additional information detecting means. However official notice may be taken that the use of such a step is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Park. It would be desirable to do so since this would aid in the user determination if the content is a valid or unauthorized copy.

As for claim 128, the claim recites substantially the same limitations as claim 105 and is therefore rejected on the same basis as is that claim.

***Allowable Subject Matter***

8. Claims 76-92, 106-115, 131, and 145 are allowed.
9. Claims 95 and 96 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art in the field does not teach the combination of features found in the independent claims, particularly including:

As for independent claims 76, 77: the use of medium-related information, superimposed on content data, as a control signal controlling usage of the data, combined with the claimed apparatus elements used in the manner of the applicant,

As for independent claims 78, 79, 80, and 88, the use of device-related information, superimposed on content data, as a control signal controlling usage of the data, combined with the apparatus elements utilized in the manner of the applicant,

As for claim 95, the use of a spread-spectrum technique to add the device-related information to the content data,

Art Unit: 2137

As for claim 96, the addition of the device-related information to the content data as a minute-level signal.

**Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents teach systems of content watermarking and usage control pertinent to the applicant's disclosure:

Warren et al. 5,719,937

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

PEC  
12-07-06



EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER